

REMARKS:

Claims 2-11, 13-19, and 21-42 are currently pending in the application.

Claims 28 and 35 stand rejected under 35 U.S.C. § 101. Claims 2-4, 6, 8-11, 13-15, 17, 19, 21-23, 25, and 27-42 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,732,161 to Hess et al. ("*Hess*") in view of U.S. Publication No. 2003/0050958 to Keller, et al. ("*Keller*"). Claims 5, 7, 16, 18, 24, and 26 stand rejected under 35 U.S.C. § 103(a) over *Hess* in view of *Keller* and in further view of U.S. Patent No. 6,091,835 to Smithies, et al. ("*Smithies*").

A Final Office Action in the subject Application was mailed to the undersigned on 12 April 2006, which provides for a response period ending 12 July 2006. The Applicant filed an Amendment After Final on 5 May 2006, within two (2) months of the date of the Final Office Action. An Advisory Action was mailed to the undersigned on 7 June 2006. The Advisory Action stated that the proposed Amendments filed on 5 May 2006 will not be entered because they raise new issues that would require further consideration and/or search. (7 June 2006 Advisory Action, Page 1). The Advisory Action further stated that the proposed amendments to independent claims 28, 30, 35, and 42 require a new search. (7 June 2006 Advisory Action, Page 2). The Applicant respectfully reiterates here the arguments set forth in the Amendment After Final filed on 5 May 2006, as if fully set forth herein.

Although the Applicant believes that claims 2-11, 13-19, and 21-42 are directed to patentable subject matter and are in condition for allowance without amendment. The Applicant has amended independent claims 28, 30, 35, and 42 in an effort to expedite prosecution of this Application and to more particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. In addition, the Applicant has also canceled dependent claims 9, 36, and 37 without prejudice. By making these amendments, the Applicant makes no admission concerning the merits of the Examiner's rejection, and respectfully reserve the right to address any statement or averment of the Examiner not specifically addressed in this response. Particularly, the Applicant expressly

reserves the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

REJECTION UNDER 35 U.S.C. § 101:

The Applicant thanks the Examiner for withdrawing the 35 U.S.C. § 101 rejection of claims 28 and 35.

CLAIM OBJECTIONS:

The Examiner objected to claims 36 and 37 because of certain informalities. Specifically, the Examiner stated that claims 36 and 37 are duplicate claims of claims 21 and 22, respectively, all depending on claim 42. (12 April 2006 Final Office Action, Page 2). The Applicants respectfully disagree. Nonetheless, the Applicant has canceled claims 36 and 37, without prejudice in an effort to expedite prosecution of this Application and to more particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. By making these amendments, the Applicant does not indicate agreement with or acquiescence to the Examiner's position with respect to the objection of these claims, as set forth in the Office Action.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 2-4, 6, 8-11, 13-15, 17, 19, 21-23, 25, and 27-42 stand rejected under 35 U.S.C. § 103(a) over *Hess* in view of *Keller*. Claims 5, 7, 16, 18, 24, and 26 stand rejected under 35 U.S.C. § 103(a) over *Hess* in view of *Keller* and in further view of *Smithies*.

Although the Applicant believes independent claims 2-11, 13-19, and 21-42 are directed to patentable subject matter and are in condition for allowance without amendment. The Applicant has amended independent claims 28, 30, 35, and 42 in an effort to expedite prosecution of this Application and to more particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. In

addition, the Applicant has also canceled dependent claims 9, 36, and 37 without prejudice. By making these amendments, the Applicant does not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 103(a), as set forth in the Office Action.

The Applicant respectfully submits that *Hess* or *Keller* either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 2-4, 6, 8-11, 13-15, 17, 19, 21-23, 25, and 27-42. The Applicant further submits that *Hess*, *Keller*, or *Smithies*, either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 5, 7, 16, 18, 24, and 26. Thus, the Applicant respectfully traverses the Examiner's obvious rejection of claims 2-11, 13-19, and 21-42 under 35 U.S.C. § 103(a) over the proposed combination of *Hess*, *Keller*, and *Smithies*, either individually or in combination.

The Proposed *Hess-Keller* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant Claims

For example, with respect to amended independent claim 30, this claim recites:

An ***electronic commerce system for third party document reuse of past transaction documents***, the system comprising:

one or more ***document repositories storing a plurality of transaction documents each associated with a past transaction of a party to the transaction document*** and at least portions of each transaction document ***capable of being used to facilitate a transaction with one or more of the parties to the transaction document***,

a ***global content directory including a plurality of classes*** organized in a hierarchy, each class categorizing the transaction documents and associated with one or more attributes of the transaction documents categorized in the class, ***at least one of the classes having one or more associated pointers that identify one or more document repositories***;

an intelligence module operable to, in response to selection of a transaction document ***by a party who was not a party to the past transaction*** associated with the transaction document, ***remove from the selected transaction document information specific to the past transaction and create a generic document*** capable of being used to facilitate a future transaction with at least one of the parties from the

selected transaction document stored in the one or more document repositories;

a security module associated with the global content directory, the security module **operable to encrypt at least a portion of the selected information in the selected transaction document thereby making it inaccessible in the generic document**, and

a search interface operable to **communicate a search query for transaction documents to one or more document repositories** identified by one or more pointers associated with one or more selected classes. (Emphasis Added).

Amended independent claims 28, 35, and 42 recite similar limitations. *Hess* or *Keller* either individually or in combination, fail to disclose, teach, or suggest each and every element of independent claims 28, 30, 35, and 42.

The Applicant respectfully submits that *Hess* has nothing to do with amended independent claim 30 limitations regarding an **“electronic commerce system for third party document reuse of past transaction documents”**. In particular, the Examiner equates the **“electronic commerce system for third party document reuse of past transaction documents”** recited in amended independent claim 30 with the “on-line system for person to person trading where user’s item images are harvested, stored and made available for users for a defined duration” purportedly disclosed in *Hess*. (12 April 2006 Final Office Action, Page 3). The Applicant respectfully disagrees. In fact, the on-line system for person to person trading disclosed in *Hess* is “facilitated by providing **prospective buyers the ability to quickly preview [images of] items for sale**”. (Column 2, Lines 5-15). (Emphasis Added). These **images of items for sale** disclosed in *Hess* are merely thumbnail images provided for presentation purposes only and **do not include, involve, or even relate to a third party document or even a past transaction document, as recited in amended independent claim 30**. In addition, the Examiner acknowledges and the Applicant agrees that these **images of items for sale** are merely **thumbnail images**, specifically, the Examiner asserts “where thumbnail images are aggregated into web page for presenting to the buyer [...] thumbnail images.” (12 April 2006 Final Office Action, Page 14).

In contrast, the “**electronic commerce system**” recited in amended independent claim 30 is provided for “**third party document reuse of past transaction documents**”. *Hess* cannot provide an “**electronic commerce system for third party document reuse of past transaction documents**”, since *Hess* does not teach, suggest, or even hint at anything more than a passive non-transactional quick preview of **thumbnail images of items for sale**, which have **not been** the subject of a transaction or which are **not likely to have been** the subject of a transaction by the prospective buyer or any other persons associated with the on-line trading system. Thus, the Applicant respectfully submits that the equations forming the foundation of **the Examiner’s comparison between Hess and amended independent claim 30 cannot be made**. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent claim 30 from *Hess*.

The Applicant further submits that *Hess* has nothing to do with amended independent claim 30 limitations regarding “one or more **document repositories storing a plurality of transaction documents each associated with a past transaction of a party to the transaction document** and at least portions of each transaction document **capable of being used to facilitate a transaction with one or more of the parties to the transaction document**”. In particular, the Examiner equates “one or more **document repositories storing a plurality of transaction documents each associated with a past transaction of a party to the transaction document**” recited in amended independent claim 30 with the “user items for sale are retrieved from repository and populated into web pages for serving as a trading document” purportedly disclosed in *Hess*. (12 April 2006 Final Office Action, Page 3). **The Applicant respectfully disagrees and further requests the Examiner to point to the portions of Hess, which state this purported disclosure**. For example, the Applicants respectfully request the Examiner to point to the portions of *Hess* which state the “user items for sale are retrieved from repository and populated into web pages for serving as a trading document”. The Applicant respectfully submits that the user items for sale in *Hess* are provided for presenting the items in a predefined page format and **have nothing to do with a past transaction** or even a past item of the user in *Hess*. (Column 8, Line 62 through Column 9, Line 46). In contrast, the “one or more **document repositories storing a plurality of**

transaction documents” recited in amended independent claim 30 are “***each associated with a past transaction of a party to the transaction document***”. Hess cannot provide “one or more ***document repositories storing a plurality of transaction documents***”, since Hess does not teach, suggest, or even hint at each of the plurality of transaction documents “***associated with a past transaction of a party to the transaction document***”, in the first place. Thus, the Applicant respectfully submits that the equations forming the foundation of ***the Examiner’s comparison between Hess and amended independent claim 30 cannot be made***. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent claim 30 from Hess.

The Applicant respectfully submits that ***the Office Action acknowledges***, and the Applicant agrees, ***that Hess fails to disclose the emphasized limitations noted above in amended independent claim 30***. Specifically the Examiner acknowledges that Hess fails to disclose the “***transaction documents, each associated with a past transaction of a party to the transaction document***.” (12 April 2006 Final Office Action, Page 4). However, the Examiner asserts that the cited portions of *Keller* disclose the acknowledged shortcomings in Hess. The Applicant respectfully traverses the Examiner’s assertions regarding the subject matter disclosed in *Keller*.

The Applicant further respectfully submits that *Keller* has nothing to do with amended independent claim 30 limitations regarding an “***electronic commerce system for third party document reuse of past transaction documents***” and in particular *Keller* has nothing to do with amended independent claim 30 limitations regarding “one or more ***document repositories storing a plurality of transaction documents each associated with a past transaction of a party to the transaction document*** and at least portions of each transaction document ***capable of being used to facilitate a transaction with one or more of the parties to the transaction document***”. In particular, the Examiner equates the “one or more ***document repositories storing a plurality of transaction documents each associated with a past transaction of a party to the transaction document***” recited in amended independent claim 30 with “the transaction log records” disclosed in *Keller*. (12 April 2006 Final Office Action, Page 4). The Applicant respectfully

disagrees. In fact, the transaction log records in *Keller* are merely a table that stores information that can later be accessed by retailers and has nothing to do with a past transaction of a party to the transaction document, but merely allows retailers (whether or not they are a party to the transaction) access to the information. (Page 4, Paragraphs 0042 and 0043). In contrast, the “one or more **document repositories storing a plurality of transaction documents each associated with a past transaction of a party to the transaction document**”, recited in amended independent claim 30 are a transactional document, not a transaction log table, that is associated with a past transaction of a party to the transaction document. *Keller* cannot provide “one or more **document repositories storing a plurality of transaction documents each associated with a past transaction of a party to the transaction document**”, since *Keller* does not teach, suggest, or even hint at a party associated with, or even a retailer associated with, a past transaction, in the first place. Thus, the Applicant respectfully submits that the equations forming the foundation of **the Examiner’s comparison of the combination of Hess and Keller to amended independent claim 30, of the subject Application, cannot be made**. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent claim 30 from *Hess and Keller*.

The Applicant still further submits that *Hess* or *Keller* have nothing to do with amended independent claim 30 limitations regarding a “**global content directory including a plurality of classes** organized in a hierarchy, each class categorizing the transaction documents and associated with one or more attributes of the transaction documents categorized in the class, **at least one of the classes having one or more associated pointers that identify one or more document repositories**”. In particular, the Examiner equates “**at least one of the classes having one or more associated pointers that identify one or more document repositories**” recited in amended independent claim 30 with “order information in the transaction log is associated with a specific repository” purportedly disclosed in *Keller*. (12 April 2006 Final Office Action, Pages 4-5). The Applicant respectfully disagrees and the Applicant further respectfully submits that **the Examiner has mischaracterized the cited text of Keller**. In fact, the cited text in *Keller* merely provides for orders to be entered through

the internet by retailers and captured in a database associated with the manufacturer, this cited text of *Keller* **does not include, involve, or even relate to a global content directory including a plurality of classes** organized in a hierarchy **or even at least one of the classes having one or more associated pointers that identify one or more document repositories, as recited in amended independent claim 30**. (Page 4, Paragraphs 0046 and 0047). In contrast, the “**at least one of the classes having one or more associated pointers that identify one or more document repositories**”, recited in amended independent claim 30 is associated with a **global content directory** and each class is associated with an attribute of the transaction document, categorized in that class. Thus, the Applicant respectfully submits that the equations forming the foundation of **the Examiner’s comparison of the combination of Hess and Keller to amended independent claim 30, of the subject Application, cannot be made**. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent claim 30 from *Hess and Keller*.

The Applicant yet further respectfully submits that *Hess* or *Keller* have nothing to do with amended independent claim 30 limitations regarding an “**intelligence module operable to**, in response to selection of a transaction document **by a party who was not a party to the past transaction** associated with the transaction document, **remove from the selected transaction document information specific to the past transaction and create a generic document** capable of being used to facilitate a future transaction with at least one of the parties from the selected transaction document stored in the one or more document repositories”. In particular, the Examiner equates the “**intelligence module**” recited in amended independent claim 30 with “security techniques to protect data from unauthorized access” disclosed in *Keller*. (12 April 2006 Final Office Action, Pages 5-6). The Applicant respectfully disagrees. In fact, even if *Keller* discloses, which it does not, it clearly does not, a manufacturer’s ability to download its own database and protect data by security techniques so that there is little risk of unauthorized disclosure of one manufacturer’s information to another manufacturer”. (Page 2, Paragraph 0015). *Keller* does not disclose, teach, or suggest an “**intelligence module operable to**, in response to selection of a transaction

document *by a party who was not a party to the past transaction* associated with the transaction document, *remove from the selected transaction document information specific to the past transaction and create a generic document* capable of being used to facilitate a future transaction with at least one of the parties from the selected transaction document stored in the one or more document repositories". It appears that the Examiner is purporting to establish that the security techniques in *Keller* are some how related to "*creat[ing] a generic document* capable of being used to facilitate a future transaction with at least one of the parties from the selected transaction document stored in the one or more document repositories", in the subject Application. However, as pointed out by the Examiner, this is not possible. (12 April 2006 Final Office Action, Page 11).

In fact, the Applicant respectfully submits that *the Office Action acknowledges*, and the Applicant agrees, *that Hess and Keller fail to disclose "remov[ing] from the selected transaction document information in the sections specific to the past transaction to create the generic document capable of being used to facilitate the future transaction."* (12 April 2006 Final Office Action, Page 11). This being the case, *Hess and Keller* cannot provide for an "*intelligence module operable to*, in response to selection of a transaction document *by a party who was not a party to the past transaction* associated with the transaction document, *remove from the selected transaction document information specific to the past transaction and create a generic document* capable of being used to facilitate a future transaction with at least one of the parties from the selected transaction document stored in the one or more document repositories", as acknowledged by the Examiner. Thus, the Applicant respectfully submits that the equations forming the foundation of *the Examiner's comparison of the combination of Hess and Keller to amended independent claim 30, of the subject Application, cannot be made*. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent claim 30 from *Hess and Keller*.

The Applicant further respectfully submits that *Hess* or *Keller* have nothing to do with amended independent claim 30 limitations regarding a "*security module* associated

with the global content directory, the security module **operable to encrypt at least a portion of the selected information in the selected transaction document thereby making it inaccessible in the generic document**". In fact, it is clear that the security techniques in *Keller* are distinct and non-analogous to the "**security module** associated with the global content directory", in the subject application. **Even assuming for the sake of argument that the security techniques in Keller are some how analogous to the encrypting in the subject application, which they are not, in fact they are clearly not**, there is still no disclosure, teaching, or suggestion in *Keller* that there is a "**security module** associated with the global content directory, the security module **operable to encrypt at least a portion of the selected information in the selected transaction document thereby making it inaccessible in the generic document**". Thus, the Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent claim 30 from *Hess and Keller*.

The Applicant still further respectfully submits that *Hess* or *Keller* have nothing to do with amended independent claim 30 limitations regarding a "**search interface** operable to **communicate a search query for transaction documents to one or more document repositories** identified by one or more pointers associated with one or more selected classes". In particular, the Examiner equates the "**search interface**" recited in amended independent claim 30 with the SQL SELECT statement disclosed in *Keller*. (12 April 2006 Final Office Action, Page 6). The Applicant respectfully disagrees and the Applicant further respectfully submits that **the Examiner has mischaracterized the cited text of Keller**. In fact, the cited text in *Keller* merely provides for orders that are entered by retailers to be used in other parts of the system. (Page 4, Paragraphs 0046 and 0047). In contrast, the "**search interface**", recited in amended independent claim 30 is "**operable to communicate a search query for transaction documents to one or more document repositories** identified by one or more pointers associated with one or more selected classes." Thus, the Applicant respectfully submits that the equations forming the foundation of **the Examiner's comparison of the combination of Hess and Keller to amended independent claim 30, of the subject Application, cannot be made**. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent claim 30 from *Hess and Keller*.

The Office Action has Failed to Properly Establish a *Prima Facie* case of Obvious over the Proposed *Hess-Keller* Combination

The Applicant respectfully submits that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Hess* or *Keller*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that “it would have been obvious to one having ordinary skill in the art at the time of the applicant’s invention was made to combine *Keller*’s teaching with *Hess* reference ***because both references are devoted to e-commerce and transaction document processing***”. (12 April 2006 Final Office Action, Page 4). The Applicant respectfully disagrees.

The Applicant further respectfully submits that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Hess* or *Keller*, either individually or in combination. In fact, the Examiner’s statement that “***because both references are devoted to e-commerce and transaction document processing***”, merely presupposes what it concludes and is an impermissible assumption under 35 U.S.C. § 103(a). The Examiner asserts that the motivation to combine the references as proposed would be “***to enhance on-line trading by quicker previewing items via an on-line facility which provides user [sic] of a supplier information about the status of the transactions involving the products of the supplier.***” (12 April 2006 Final Office Action, Page 4). The Applicant respectfully disagrees and further respectfully request clarification as to how the Examiner arrives at this conclusion. For example, how does “***quicker previewing items***” directly “***enhance on-line trading***” and to what extent does the Examiner purport that “***the status of the transactions involving the products of the supplier***” applies to the subject Application. ***The Applicant respectfully requests the Examiner to point to the portions of Hess or Keller which contain the teaching, suggestion, or motivation to combine these references for the for the Examiner’s stated purported advantage.*** In particular, the Applicant respectfully requests the Examiner to point to the portions of *Hess* or *Keller* which expressly state that “***quicker***

previewing items” directly “***enhance on-line trading***”. The Applicant further submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.*** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the ***Examiner has not adequately supported the selection and combination of Hess or Keller to render obvious the Applicant’s claimed invention.*** The Examiner’s conclusory statements that “it would have been obvious to one having ordinary skill in the art at the time of the applicant’s invention was made to combine *Keller’s* teaching with *Hess* reference ***because both references are devoted to e-commerce and transaction document processing***” and “***to enhance on-line trading by quicker previewing items via an on-line facility which provides user of a supplier information about the status of the transactions involving the products of the supplier***”, ***does not adequately address the issue of motivation to combine.*** (12 April 2006 Final Office Action, Page 4). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to “[use] that which the inventor taught against its teacher.” *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, ***the Office Action fails to provide proper motivation for combining the teachings of Hess or Keller***, either individually or in combination.

The Proposed *Hess-Keller-Smithies* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant’s Dependent Claims 5, 16, and 24

The Applicant respectfully submits that *Hess*, *Keller*, or *Smithies*, either individually or in combination, fails to disclose, teach, or suggest each and every element of dependent claims 5, 16, and 24. Thus, the Applicant respectfully traverses the Examiner's obvious rejection of dependent claims 5, 16, and 24 under 35 U.S.C. § 103(a) over the proposed combination of *Hess*, *Keller*, and *Smithies*, either individually or in combination.

For example, with respect to dependent claim 5, this claim recites:

The system of Claim 30, wherein ***the intelligence module***: segments the selected transaction document into one or more sections;

determines which sections of the selected transaction document are generic and which sections are specific to the past transaction; and

removes from the selected transaction document information in the sections specific to the past transaction to create the generic document capable of being used to facilitate the future transaction; and

carries forward the generic sections from the selected transaction document into the generic document to protect one or more confidential details in the selected transaction document. (Emphasis Added).

Dependent claims 16 and 24 recite similar limitations. *Hess*, *Keller*, or *Smithies*, either individually or in combination, fail to disclose, teach, or suggest each and every element of dependent claims 5, 16, and 24.

The Applicant respectfully submits that the Office Action acknowledges, and the Applicant agrees, that *Hess* and *Keller* fail to disclose the emphasized limitations noted above in dependent claim 5. Specifically the Examiner acknowledges that *Hess* and *Keller* fails to teach "***removes from the selected transaction document information in the sections specific to the past transaction to create the generic document capable of being used to facilitate the future transaction***". (12 April 2006 Final Office Action, Page 11). However, the Examiner asserts that the cited portions of *Smithies* disclose the acknowledged shortcomings in *Hess* and *Keller*. The Applicant respectfully traverses the Examiner's assertions regarding the subject matter disclosed in *Smithies*.

The Applicant further respectfully submits that *Smithies* has nothing to do with dependent claim 5 limitations regarding "***remove[ing] from the selected transaction***

document information in the sections specific to the past transaction to create the generic document capable of being used to facilitate the future transaction".

Rather *Smithies* discloses a system for providing a transcript of a single party during a voluntary statement memorializing circumstances which may help the party remember the circumstances in the future. (Abstract and Column 13, Lines 32-41). *Smithies* merely discloses this system for providing a transcript to help a single party remember circumstances in the future and does not teach, suggest, or even hint at ***"remove[ing] from the selected transaction document information in the sections specific to the past transaction to create the generic document capable of being used to facilitate the future transaction"***. Thus, *Smithies* cannot provide ***"remove[ing] from the selected transaction document information in the sections specific to the past transaction to create the generic document capable of being used to facilitate the future transaction"***, since *Smithies* does not even provide ***a past transactional document***, a past transcript, or even any other type of past document stored in a document repository that provides for selected information to be made inaccessible in a created generic document.

The Office Action has Failed to Properly Establish a *Prima Facie* case of Obvious over the Proposed Hess-Keller-Smithies Combination

The Applicant respectfully submits that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Hess*, *Keller*, or *Smithies*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine *Hess*, *Keller*, and *Smithies* as proposed. The Office Action merely states that "it would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine *Smithies*' teaching with *Keller* and *Hess* references ***because the references are devoted to e-commerce and transaction document processing***". (12 April 2006 Final Office Action, Pages 11-12). The Applicant respectfully disagrees.

The Applicant further respectfully submits that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Hess, Keller, or Smithies*, either individually or in combination. As mentioned above, the Examiner's statement that **"because both references are devoted to e-commerce and transaction document processing"**, merely presupposes what it concludes and is an impermissible assumption under 35 U.S.C. § 103(a). The Examiner asserts that one of ordinary skill in the art at the time of the invention would have been motivated to **"enhanc[e] Hess system's functionality by the implementation of flexibility updating e-commerce trading transaction document."** (12 April 2006 Final Office Action, Pages 11-12). The Applicant respectfully disagrees and further respectfully request clarification as to how the Examiner arrives at this conclusion. For example, how does **"implementation of flexibility updating e-commerce trading transaction document"** directly **"enhance Hess system's functionality"** and to what extent does the Examiner purport that the **"implementation of flexibility updating e-commerce trading transaction document"** applies to the subject application. **The Applicant respectfully requests the Examiner to point to the portions of Hess, Keller, or Smithies, which contain the teaching, suggestion, or motivation to combine Hess, Keller, or Smithies for the Examiner's stated purported advantage.** In particular, the Applicant respectfully requests the Examiner to point to the portions of *Hess, Keller, or Smithies* which expressly state that **"implementation of flexibility updating e-commerce trading transaction document"** directly **"enhance Hess system's functionality"**. The Applicant further submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the **prior art must disclose each and every element of the claimed invention**, and that **any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, **the Examiner has not adequately supported the selection and combination of Hess, Keller, or Smithies to render obvious the Applicant's claimed**

invention. The Examiner's conclusory statements that "it would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine *Smithies'* teaching with *Keller* and *Hess* references ***because the references are devoted to e-commerce and transaction document processing***" and to "***enhanc[e] Hess system's functionality by the implementation of flexibility updating e-commerce trading transaction document***", ***does not adequately address the issue of motivation to combine.*** (12 April 2006 Final Office Action, Pages 11-12). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, ***the Office Action fails to provide proper motivation for combining the teachings of Hess, Keller, or Smithies,*** either individually or in combination.

The Proposed *Hess-Keller-Smithies* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Dependent Claims 7, 18, and 26

The Applicant respectfully submits that *Hess, Keller, or Smithies*, either individually or in combination, fails to disclose, teach, or suggest each and every element of dependent claims 7, 18, and 26. Thus, the Applicant respectfully traverses the Examiner's obvious rejection of dependent claims 7, 18, and 26 under 35 U.S.C. § 103(a) over the proposed combination of *Hess, Keller, and Smithies*, either individually or in combination.

For example, with respect to dependent claim 7, this claim recites:

The system of Claim 5, wherein ***the intelligence module*** is further operable to ***dynamically adjust the information in the sections in the generic document*** to include current information. (Emphasis Added).

Dependent claims 18 and 26 recite similar limitations. *Hess, Keller, or Smithies*, either individually or in combination, fail to disclose, teach, or suggest each and every element of dependent claims 7, 18, and 26.

The Applicant respectfully submits that the Office Action acknowledges, and the Applicant agrees, that *Keller* and *Smithies* do not disclose the limitations recited in dependent claim 7. However, the Examiner asserts that the cited portions of *Hess* disclose the acknowledged shortcomings in *Keller* and *Smithies*. The Applicant respectfully disagrees. In particular, the Examiner equates ***“the intelligence module is further operable to dynamically adjust the information in the sections in the generic document to include current information”*** recited in dependent claims 7, 18, and 26 with a “harvesting process [that] periodically reloads images and updates thumbnails” disclosed in *Hess*. (12 April 2006 Final Office Action, Page 12). The Applicant respectfully disagrees. In fact, the harvesting process in *Hess* “downloads user-specified images associated with newly listed items to its local database”. (Column 6, Lines 31-42). In contrast, the ***“intelligence module”*** recited in dependent claim 7 ***“dynamically adjust[s] the information in the sections in the generic document to include current information”***. *Hess* cannot provide an ***“intelligence module”*** that ***“dynamically adjust[s] the information in the sections in the generic document to include current information”***, since *Hess* does not teach, suggest, or even hint at anything more than a passive download process of thumbnail images associated with newly listed items. Thus, the Applicant respectfully submits that the equations forming the foundation of ***the Examiner’s comparison between Hess and dependent claim 7 cannot be made***. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish dependent claim 7 from *Hess*, *Keller*, or *Smithies*, either individually or in combination.

The Applicant’s Claims are Patentable over the Proposed *Hess-Keller-Smithies* Combination

The Applicant respectfully submits that amended independent claims 28, 35, and 42 include limitations similar to those discussed above in connection with amended independent claim 30. Thus, amended independent claims 28, 35, and 42 are considered patentably distinguishable over the proposed combination of *Hess*, *Keller*, and *Smithies* for at least the reasons discussed above in connection with amended independent claim 30.

With respect to dependent claims 2-8, 10, 11, 13-19, 21-27, 29, 31-34, and 38-41: claims 2-8, 10, 11, and 29 depend from amended independent claim 30; claims 13-17, 19, and 31-34 depend from amended independent claim 35; and claims 21-25, 27, and 38-41 depend from amended independent claim 42. As mentioned above, each of amended independent claims 28, 30, 35, and 42 are considered patentably distinguishable over the proposed combination of *Hess, Keller, and Smithies*. Thus, dependent claims 2-8, 10, 11, 13-19, 21-27, 29, 31-34, and 38-41 are considered patentably distinguishable over the proposed combination of *Hess, Keller, and Smithies* for at least the reasons of depending from an allowable claim and are therefore considered to be in condition for allowance.

For at least the reasons set forth herein, the Applicant submits that claims 2-8, 10, 11, 13-19, 21-35, and 38-42 are not rendered obvious by the proposed combination of *Hess, Keller, and Smithies*, or in knowledge generally available to those of ordinary skill in the art at the time of the invention. The Applicant further submits that claims 2-8, 10, 11, 13-19, 21-35, and 38-42 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of claims 2-8, 10, 11, 13-19, 21-35, and 38-42 under 35 U.S.C. § 103(a) be reconsidered and that claims 2-8, 10, 11, 13-19, 21-35, and 38-42 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.*** Second, there must be a reasonable expectation of success. Finally, ***the prior art reference*** (or references when combined) ***must teach or suggest all the claim limitations.*** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and ***not based on applicant's disclosure.*** *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C.

§ 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, ***there must be something in the prior art as a whole to suggest the desirability***, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

A Request for Continued Examination (RCE) is being filed in duplicate concurrently herewith to facilitate the processing of this deposit account authorization. **The Commissioner is hereby authorized to charge the RCE Fee of \$790.00 to Deposit Account No. 500777.** Because this Amendment is filed prior to the ending of the response period 12 July 2006 of the Final Office Action mailed on 12 April 2006, no additional fees are deemed to be necessary; however, the undersigned hereby authorizes the Commissioner to charge any additional fees that may be required, or credit any overpayments, to **Deposit Account No. 500777.**

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

6/26/06
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